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EXAMINER				
AL-AWADI, DANAH J				
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1615				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/595,745

**Applicant(s)**

BRET ET AL.

**Examiner**

DANAH AL-AWADI

**Art Unit**

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-08)  
Paper No(s)/Mail Date 2 page/10/15/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Receipt is acknowledged of Applicant's amendments and remarks filed 10/15/2009. The Examiner acknowledges the following:

Claims 1-14 were previously cancelled.

No claims have been amended.

Thus, claims 15-29 represent all claims currently pending.

### ***INFORMATION DISCLOSURE STATEMENT***

Information Disclosure Statement filed 15 October 2009, is acknowledged and has been reviewed.

### **New Rejections**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 15 recites having an agent comprising at least one fatty acid ester wherein a carbon chain of which is of C10-C14 and of alcohol a carbon chain of which is of C10-C14. It is unclear if the alcohol of carbon chain of which is C10-C14 is the alcohol which forms the ester or if it is a separate alcohol chain in addition to the ester. The way the claim is written is unclear and it appears to be written that the alcohol is what is forming the ester group. Note claims 16-29 were also included because of their dependency from 15.

### **Maintained Rejections**

The following rejection has been maintained from the previous office action dated (07/16/2009):

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15-22, 24, and 26-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Bret et al. (US Patent 6146648).

Bret et al. U.S. Patent 6146648 (hereafter '648 patent) teaches a composition that comprises a waxy ester and a fatty alcohol on a fibrous material for use in contacting skin. The purpose of the composition is to make the fibrous material softer. Regarding the fatty acid ester of claim 15 in the instant application, Claim 4 of '648 patent states that the composition was derived from one or more fatty alcohols which have 6 to 24 carbon atoms. Claim 4 further states a waxy ester also derived from saturated linear fatty acids having from 6 to 24 carbon atoms. With respect to the specific range of carbon atoms stated, chapter 2144.05 of MPEP states "In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. With respect to the range of the amount of product per surface area, chapter 2144.05 states "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."

With regards to the fibrous material imparting a sense of freshness of pending claim 15, this is treated as intended use and carries little patentable weight.

With regards to the melting temperature of claim 16 of the instant application, Claim 1 of '648 patent states that the composition melts at least 5°C, and therefore the composition also melts at a range from 20°C to 37°C.

Claim 17 of the instant application calls for a composition of at least 40% being selected from solvents, fatty acid esters, fatty alcohols, or mineral oils. Claim 8 (i) of '648 patent teaches that the composition comprises from 0 to 50% of wax or mineral oil.

Claims 18 and 19 of the instant application discuss dodecylic esters. Claim 4 of '648 patent teaches a waxy ester of 6 to 24 carbon atoms. With respect to the specific range of carbon atoms stated, chapter 2144.05 of MPEP states "In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists." A dodecylic ester is a 12 carbon ester. Furthermore, Paragraph 83 of the brief summary '648 patent teaches lauric acid which is dodecanoic acid. With respect to the percentage, claim 20 part (b) of '648 patent teaches a composition from 5 to 99% wt of an aqueous emollient compound of which is comprised of at least one waxy ester. Furthermore, claim 8 of '648 patent teaches a composition which comprises from 1 to 50% of waxy esters. Dodecylic acid is a waxy ester. With respect to the percentages in the instant claims 17 and 18, chapter 2144.05 of MPEP states that "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."

Claim 20 of the instant application states the agent is distributed substantially on the surface of the product. Paragraph 1 of the brief summary of '648 patent states that "the lotion is applied or impregnated onto at least on surface..." Impregnated onto is understood to be applied substantial to the surface.

With respect to the range of the amount of product per surface area of claims 21 and 22 of the instant application, chapter 2144.05 of the MPEP states "Where the general conditions of a

claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.”

With regards to the distribution of the agent in strips parallel to each other in claim 24 of the instant application, Paragraph 131 of the brief description of ‘648 patent discloses a method of depositing lotion in the form of strips.

Claim 26 of the instant application states the agent is distributed over a top surface and a bottom surface of said product. Paragraph 25 of the detailed description of ‘648 patent states that an object of the invention is to provide a paper product which has at least one surface that is coated with an agent, of which is lotion. Therefore, distributing the agent over the top surface and bottom surface is at least one surface.

Claim 27 of the instant application states that the fibrous material comprises absorbent paper. Claim 20 of ‘648 patent teaches absorbent paper product. Absorbent paper is fibrous material.

Claims 28 and 29 of the instant application discuss that the fibrous material comprises absorbent cotton or a bonded web of natural, artificial, or synthetic textile fibers. Claim 20 of ‘648 patent teaches absorbent paper, and absorbent paper is made of up of natural, artificial, or synthetic textile fibers. Cotton or cotton in mixture with artificial or synthetic fibers is an obvious version of absorbent paper. The abstract of ‘648 patent teaches that the composition is used in treating absorbent paper products of which include according to Paragraph 2 of the brief summary, paper products paper products such as handkerchiefs, toilet paper, or any other paper products for wiping the skin. Furthermore, Paragraph 1 of the brief summary of ‘648 patent teaches that the paper product can include a sheet of wadding cotton or tissue paper. Paragraph

27 of the brief summary of '648 patent teaches an absorbent paper sheet made up of mostly paper fibers and of synthetic fibers or any other equivalent paper product.

Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bret et al. US Patent 6146648 as applied to claims 15-22, 24, and 26-29 above, and further in view of Wegele et al US Patent 6270878.

Claims 23 -26 of the instant application discuss distribution patterns of the agent. US patent 6270878 (hereafter '878 patent) discloses that it is advantageous to have a wipe that has a discontinuous distribution pattern. Paragraph 9 of the brief summary of '878 patent teaches that a continuous pattern of emulsion has been found to not provide the most efficacious cleaning of human skin. It is known in the art that distribution is normally done in a continuous fashion.

With regards to a discontinuous manner, the strips are parallel; it is therefore understood to also be distributed in a discontinuous manner. In regards to claim 26 of the instant application, distribution over a top surface and a bottom surface is also an obvious variant of discontinuous distribution.

The teachings of '648 patent doesn't disclose distribution patterns, however the '878 patent discloses known distribution patterns of emollient, and the claimed distribution patterns of the instant application are obvious variants and do not add patentable weight. It would have been prima facie obvious to combine the teachings of '878 patent with the teachings of '648 patent because '878 patent teaches a composition distribution having the advantage of more efficacious cleaning of human skin.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bret et al. US Patent 6146648 as applied to claims 15-22, 24, and 26-29 above, and further in view of Muoio US patent 3965518.

U.S. Patent 3965518 (hereafter '518 patent) discloses the advantage of the continuous application. Paragraph 6 and 7 the brief summary of '518 patent discloses an advantage of continuous distribution in that it provides an even application of product.

The teachings of '648 patent doesn't disclose distribution patterns, however the '518 patent discloses known distribution patterns of emollient, and the claimed distribution patterns of the instant application are obvious variants and do not add patentable weight. It would have been prima facie obvious to combine the teachings of '518 patent with the teachings of '648 patent because '518 patent teaches a composition distribution having the advantage of a more even application of product.

### **RESPONSE TO ARGUMENTS**

Applicant's arguments with regard to the rejection of claims 15-22, 24, and 26-29 under 35 U.S.C.103(a) over Bret et al. US Patent 6,146,648, has been fully considered, but they are not persuasive.

Applicant alleges that Bret et al. US Patent 6,146,648 (hereafter the '648 patent) does not teach or suggest a fibrous material that imparts a sense of freshness where the product contains, in part, at least one fatty acid ester with a C10-C14 carbon chain and a alcohol with a C10-C14 carbon chain. Applicant states that in contrast the '648 patent describes a softening lotion

composition for use in an absorbent paper product, which utilizes C16+ fatty alcohols and C24+ waxy esters.

In response, Examiner respectfully submits that claim 15 of the 10/595745 application states that the agent is composed of a fatty acid ester wherein a carbon chain is C10-C14 and wherein the alcohol has a carbon chain of C10-14. It is unclear by claim 15, but believed that the alcohol is intended for reaction with a linear fatty acid to form an ester. When the alcohol is reacted to form the ester this would make for an ester that has carbon chains from minimum C20 to maximum C28. For example, as per claim 18 wherein the agent comprises at least dodecyclic ester of dodecanoic acid, this would mean that dodecanoic acid having a carbon chain length of 12 is reacted with an alcohol, which for example purposes has a chain length of 10 carbons, this would yield a fatty acid ester of 22 carbons. While it is believed by examiner that applicant intends to have a ester in addition to an alcohol, currently the manner in which claim 15 reads is unclear.

Referring to the '648 patent, this patent states that the esters are derived from liner fatty acids having 6 to 24 carbon atoms ( claim 4). At minimal the saturated fatty acids having 6 carbon atoms and a saturated liner fatty alcohol having 6 carbon atoms, would yield a fatty acid ester of C12.

Applicant has provided a declaration which has been considered but is not persuasive.

Applicant has provided a declaration which states that when making a fibrous material for imparting a freshness feeling to the skin, applicants discarded the composition of the '648 patent because a composition such as disclosed in the '648 patent does not impart a freshness feeling to the skin but only a softness.

Furthermore, the declaration states on page 4 paragraph 13 that the '648 patent teaches that the at least one acid ester must have at least 16 carbon atoms. Page 5 paragraph 17 of the declaration also states that the '648 patent teaches that the waxy ester is obtained from a linear fatty alcohol having 6 to 24 carbon atoms must have at least 16 carbon atoms. Based on applicant's remarks (10/15/2009) the statement on page 4 paragraph 13 of the declaration is confusing. It is presumed that applicants meant to say at least 24 carbon atoms based on the remarks from (10/15/2009).

In response, Examiner respectfully submits that the '745 application is currently not patentably distinct over the prior art which recognizes substantially similar carbon chain length ranges.

The '648 patent teaches having available C10-C14 alcohol and C10-C14 fatty ester. "A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. "An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties. In *re Payne*" Furthermore, 2144.09 (II) states "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH<sub>2</sub>- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In *re Wilder*."

With regards to the ester, the waxy esters taught in the '648 patent are derived from linear fatty acids with 6 to 24 carbon atoms and linear fatty alcohols with 6 to 24 carbon atoms (lines

34-38 column 8). Taking the minimal carbon chain lengths for the fatty acid and fatty alcohols this would yield a fatty acid ester of minimum 12 carbons. This fatty acid ester would yield the ester as presently claimed. Although in the preferred embodiments the fatty acid ester constitutes at least 24 carbon atoms, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Absent a showing of evidence to the contrary the prior art product would also yield beneficial effects and properties sought herein by applicant. It is expected that the same properties would be imparted on them based on application of the same components. Examiner understands the argument by applicant that the '648 patent imparts a feeling of softness and not freshness. A sense of freshness is merely a property that would be expected based on same components of the product which the art clearly recognizes and suggests. The prior art and present application differs by the mere addition of CH<sub>2</sub> groups. Furthermore, a chemical composition and its properties are inseparable. Examiner acknowledges that the sense of freshness is not intended use but that this would be an expected property of the composition. Note that a product is being claimed herein and that the prior art is well aware of obtaining the product as claimed by applicant.

Applicant's arguments with regard to the rejection of claims 23-26 under 35 U.S.C.103(a) over Bret et al. US Patent 6,146,648 in view of Wegele US Patent 6,270, 878 has been fully considered, but they are not persuasive.

Applicant's arguments with regard to the rejection of claims 25 under 35 U.S.C.103(a) over Bret et al. US Patent 6,146,648 in view of Muoio US Patent 3,965, 518 has been fully

considered, but they are not persuasive.

Applicant alleges that Wegele and Muoio do not make up for the deficiencies of Bret.

In response, Examiner respectfully submits that the response to the declaration and to the deficiencies of Bret were addressed above.

#### ***CONCLUSION***

All claims have been rejected; no claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***CORRESPONDENCE***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danah Al-awadi whose telephone number is (571) 270-7668. The examiner can normally be reached on 9:00 am - 6:00 pm; M-F (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Robert A. Wax can be reached on (571) 272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DA/  
Examiner, Art Unit 1615

/Humera N. Sheikh/  
Primary Examiner, Art Unit 1615